

Remarks

In a final Office action mailed on February 22, 2006, the Examiner rejected Applicant's claim 19 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 1,860,586, to McIlhenney (McIlhenney). Claims 20-23 were restricted as independent or distinct from the invention originally claimed. Claim 19 is discussed below.

Claim 19

On page 2 of the Office action, the Examiner states "The device of McIlhenny reads on the structural limitation of the claims including an inner box (the combination of 11 and 12) and an outer box (1). Applicant respectfully traverses. Applicant contends that the cited reference does not teach all the elements of the claim and therefore these claims are not anticipated. Applicant concludes that the Examiner has failed to meet the requirements of a *prima facie* case for anticipation.

In order to anticipate a claim, a reference must teach all the elements of a claim. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). In addition, the reference must show the claimed invention "in as complete detail as is contained in the patent claim" in order to anticipate the claimed invention. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). MPEP 2131

Claim 19 recites "an inner box of rectangular cross section with opposed top and bottom sections...said inner box having a transparent wall through which said gift is visible...." McIlhenney teaches that "the contents of the box will be packed in a tubular member 12 and entirely wrapped and sealed in a transparent paper or sheet cellophane 11 as illustrated in Figure 6." Col. 2, lines 76-79. Figures 1-3,

6-8 clearly show the outer box, but do not disclose any details of the "tubular member."

A "tubular member" is not a box. Oxford's Compact English Dictionary On-line defines a box as "a container with a flat base and sides and a lid." McIlhenney's "tubular member" suggests the 3-sided cardboard dividers found in confectioner's samplers. McIlhenney does not teach or suggest that the tubular member has a flat base, sides, and a lid, much less "an inner box of rectangular cross section with opposed top and bottom sections..." as required by Applicant's claim 19. As McIlhenney does not teach this element of Applicant's claim 19, McIlhenney does not anticipate Applicant's claim 19.

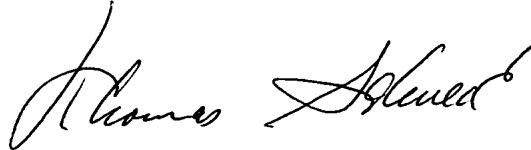
McIlhenney's "wrapped and sealed in a transparent paper or sheet cellophane" does not read on Applicant's "transparent wall." Transparent paper or sheet cellophane may not be removed in the same manner as a box top; once removed, it must be resealed by heat, tape or glue. In contrast, a box with a transparent wall may be opened, the contents removed and replaced, then closed without glue or tape. As McIlhenney does not teach an "inner box having a transparent wall," as required by Applicant's claim 19, McIlhenney does not anticipate Applicant's claim 19.

For at least the above stated reasons, Applicant's claim 19 is distinguished over the cited prior art. Applicant therefore requests that the Examiner reconsider the 35 U.S.C. §102 (b) rejection of Applicant's claim 19.

Conclusion

Applicant has distinguished the claimed invention over the cited prior art. Applicant contends that the application is in condition for allowance. A notice of allowance is earnestly solicited.

Respectfully submitted,



Thomas Schneck

Reg. No. 24,518

Schneck & Schneck

P.O. Box 2-E

San Jose, CA 95109-0005

(408) 297-9733

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signed: Merle P. Garcia
Typed Name: Merle P. Garcia

Date: May 24, 2006